

Page



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,497	03/20/2001	Bernol Goldberg	3715P2308	8901

23504 7590 06/21/2004
WEISS & MOY PC
4204 NORTH BROWN AVENUE
SCOTTSDALE, AZ 85251

EXAMINER

MEKY, MOUSTAFA M

ART UNIT	PAPER NUMBER
----------	--------------

2157

DATE MAILED: 06/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

BEST AVAILABLE COPY

Office Action Summary	Application No.	Applicant(s)	
	09/811,497	GOLDBERG, BERNOL	
	Examiner	Art Unit	
	Moustafa M Meky	2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

BEST AVAILABLE COPY

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2157

1. Claims 1-20 are presenting for examination.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4, 6-11, and 13-20 are rejected under 35 U.S.C. 102(a) & (e) as being anticipated by Chrabaszc (US Pat. No. 6,073,133).
4. As to claim 1, Chrabaszc shows in Figs 1-3, a method for completing an e-mail transmission, comprising:
 - receiving a user input indicating that an e-mail message has been completed, see col 2, lines 1-3, col 5, lines 9-11, lines 29-30, col 6, lines 35-39;
 - parsing said e-mail message for clues indicating that an attachment to said e-mail message is likely intended, see the abstract, lines 9-14, col 2, lines 10-15, col 4, lines 37-41, col 5, lines 31-36, col 6, lines 41-49;
 - determining whether or not said attachment has been attached to said message, see the abstract, lines 15-16, col 2, lines 10-15, col 4, lines 37-41, col 5, lines 31-36, col 6, lines 56-63;
 - in response to determining that said attachment has not been attached to said e-mail message, generating a user prompt to indicate to a user that an attachment

Art Unit: 2157

to said e-mail message is likely intended, see the abstract, lines 16-17, col 2, lines 18-22, col 4, lines 41-43, col 5, lines 36-37.

5. As to claim 2, Chrabaszez shows that the user input instructing the e-mail program to send the message, see col 2, lines 1-3, col 5, lines 29-30, col 6, lines 35-39.

6. As to claim 3, Chrabaszez shows that the user input instructing the e-mail program to inherently (notice the phrase send command or its equivalent) save the message, see col 5, lines 29-30, col 6, lines 35-39.

7. As to claim 4, Chrabaszez shows the use of keywords for performing the parsing step, see the abstract, lines 9-16, col 2, lines 3-22, col 4, lines 37-41, lines 43-47, col 5, lines 25-37, lines 59-64.

8. As to claims 6-7, Chrabaszez shows the use of phrases for performing the parsing step, see the abstract, lines 9-16, col 2, lines 3-22, col 4, lines 16-23, lines 37-41, lines 43-47, col 5, lines 25-37, lines 59-64.

9. As to claims 8-11, and 13-20, the claims are similar in scope to claims 1-4, and 6-7, and they are rejected under the same rationale.

Therefore, it can be seen from paragraphs 4-9 that Chrabaszez anticipates claims 1-4, 6-11, and 13-20.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2157

11. Claims 5 & 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chrabaszc (US Pat. No. 6,073,133) in view of Shiono (US Pat. No. 6,453,338).

12. As to claim 5, Chrabaszez shows in Figs 1-3, a method for completing an e-mail transmission as been discussed in paragraph 4 above. However, Chrabaszez does not teach the use of file names for parsing step. The use of file names for parsing the e-mail message to indicate the lack of attachment was well known in the art as been taught by Shiono, see the abstract, lines 14-17, col 12, lines 15-34, col 13, lines 25-69. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Shiono with the system of Chrabaszez in order to provide more flexibly and more accuracy (the use of file names in addition to the use of keywords and phrases would give the system of Chrabaszez more accuracy and more flexibility to implement the parsing step).

13. As to claim 12, the claim is similar in scope to claim 5, and it is rejected under the same rationale.

Therefore, it can be seen from paragraphs 12-13 that the combined system of Chrabaszc and Shiono teaches the limitations of claims 5 & 12.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14.1. The patent of Shiono (US pat. No. 6,453,338) and the US pending application (US2002/0107924) teaches the limitations of the pending claims 1-20.

Art Unit: 2157

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Moustafa M Meky whose telephone number is 703-305-9697. The examiner can normally be reached on flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M.M.M
June 20, 2004


MOUSTAFI M. MEKY
PRIMARY EXAMINER